

*Attorney Docket No: IDF 1693 (4000-05000)**Patent*

### REMARKS/ARGUMENTS

#### *Status of Claims*

Claims 1 and 20-21 have previously been amended.

Claims 14, 16, 27, 29, 31, and 33 have been canceled.

Claims 1-13, 15, 17-26, 28, 30, and 32 are currently pending in this application.

#### *Claims Rejections -- 35 USC § 102(e)*

Claims 1-3 and 20 stand rejected under 35 USC § 102(e) as being anticipated by *Berlovitch* (U.S. Patent 6,061,334). The Applicant respectfully traverses the rejection and submits that *Berlovitch* fails to teach each and every element of claims 1-3 and 20 as required by MPEP § 2131.

Claim 1 is not anticipated by *Berlovitch* under 35 USC § 102(e) because *Berlovitch* fails to teach the four parties disclosed in claim 1. MPEP § 2131 provides: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131 quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Claim 1 reads:

1. A method for managing change to protect the integrity of an enterprise's computer operating environment comprising the steps of:

(a) submitting a change request document by a change requester to a change manager for validation;

(b) broadcasting notice of a proposed change described in a valid change request document to at least one potentially interested operating unit within the enterprise wherein said change consists of modifications to hardware, software, or both in an electronic computing system of the enterprise;

(c) reviewing said proposed change by a review team comprising said change manager and a representative of each potentially interested operating unit receiving notification of said proposed change and choosing to participate in said review team, said review team recommending a course of action regarding said proposed change; and

(d) notifying said change requester of said review team's recommended course of action regarding said proposed change.

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*Berlovitch* does not anticipate claim 1 because *Berlovitch* fails to teach the four parties disclosed in claim 1. More specifically, *Berlovitch* discloses the involvement of two parties in his change management process: the VNS and the user. The VNS detects changes throughout the network by listening for broadcasts from various stations throughout the network, generates a VLAN configuration modification recommendation in light of the network change, and presents the proposed VLAN configuration modifications to a user for approval. The user then approves the recommended VLAN configuration modification using the pop-up window shown in FIG. 17. By contrast, claim 1 recites at least four parties involved in the change management process: the change requester, the change manager, a potentially interested operating unit and a representative from the potentially interested operating unit. As recited in the claims, these four parties perform independent functions: the change requester submits the change request document, the change manager validates the change request document, the potentially interested operating unit receives the broadcasted proposed change, and the representative reviews the proposed change. Because *Berlovitch* fails to teach two of the parties involved in the change management process, namely at least one potentially interested operating unit and a representative from each potentially interested operating unit, he does not teach each and every element of claim 1, and consequently, cannot anticipate claim 1 under 35 USC § 102(e).

In addition, *Berlovitch* fails to anticipate claim 1 because *Berlovitch* fails to teach the step of broadcasting the proposed change described in the change request document. MPEP § 2131 provides: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." As shown above, claim 1 recites the limitation "broadcasting notice of a proposed change in a valid change request document." *Berlovitch* does not teach the above broadcasting limitation. More specifically,

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*Berlovitch* teaches that the user approves (validates) the recommended VLAN configuration modification (a proposed change) using the pop-up window shown in FIG. 17 (a change request document). See *Berlovitch*, col. 29, lines 13-28. In order for *Berlovitch* to teach the "broadcasting notice of a proposed change in a valid change request document" limitation as recited in claim 1, he would have to teach "broadcasting a proposed VLAN configuration modification in an approved pop-up window." *Berlovitch* teaches no such limitation. Instead, the only broadcasting that *Berlovitch* teaches is broadcasting of a lost connection notice by the stations that lose connection to the network. See *Berlovitch*, col. 9, lines 48-53 and col. 22, lines 42-48. Broadcasting notice of a lost connection is not the same as broadcasting a proposed change in an approved pop-up window. Because *Berlovitch* fails to teach the step of broadcasting the proposed change described in the change request document, he does not teach each and every element of claim 1, and consequently, cannot anticipate claim 1 under 35 USC § 102(e).

Moreover, *Berlovitch* fails to anticipate claim 1 because *Berlovitch* fails to teach the review team. MPEP § 2131 provides: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Claim 1 recites the limitation of "a review team comprising said change manager and a representative of each potentially interested operating unit receiving notification of said proposed change and choosing to participate in said review team." As noted above, *Berlovitch* fails to teach the representative of each potentially interest operating unit. Lacking a representative, *Berlovitch* cannot teach the claimed review team. Because *Berlovitch* fails to teach the review team limitation of claim 1, he does not teach each and every element of claim 1, and consequently, cannot anticipate claim 1 under 35 USC § 102(e).

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Claims 2-3 and 20 should be allowed because *Berlovitch* fails to anticipate claim 1. Claims 2-3 are allowable because they depend on an allowable claim 1. Claim 20 is allowable because, as noted by the Examiner, claim 20 sets forth limitations similar to those found in claim 1 and claim 1 is allowable. Consequently, claims 1-3 and 20 should be allowed over the cited prior art.

**Claims Rejections – 35 USC § 103**

Claims 4-13, 15, 17-19, 21-26, 28, 30, and 32 stand rejected under 35 USC § 103(a) as being unpatentable over *Berlovitch* in view of *Zweben* (U.S. Patent 5,768,586). The Applicant respectfully traverses the rejection and submits that the Examiner has failed to present a *prima facie* case of obviousness as required by MPEP § 2143.

The Examiner's obviousness rejections are not well founded because the Examiner has not established a *prima facie* case of obviousness. The requirements for establishing a *prima facie* case of obviousness are well established:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicants' disclosure. MPEP § 2142 citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added).

Similarly, the fact that the Examiner has the burden of proof with respect to the elements of the *prima facie* case of obviousness is also well defined:

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the

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claimed invention to have been obvious in light of the teachings of the references." MPEP § 2142 quoting *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. MPEP § 2142 citing *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986).

With respect to claims 4-13, 15, 17-19, 21-26, 28, 30, and 32, the Examiner has not met his burden of presenting the *prima facie* case of obviousness with respect to the first or third prongs of the obviousness test because *Berlovitch* and *Zweben* do not teach or suggest all of the limitations of claims 4-13, 15, 17-19, 21-26, 28, 30, and 32, and there is no suggestion or motivation to combine the teachings of *Berlovitch* with the teachings of *Zweben* to obtain the invention of claims 4-13, 15, 17-19, 21-26, 28, 30, and 32.

The Examiner has not established a *prima facie* case of obviousness because *Berlovitch* and *Zweben* do not teach or suggest every claimed limitation. As explained in reference to the § 102(e) rejections above, *Berlovitch* fails to teach several of the limitations of claims 1 and 20, namely the limitations in subsections (b) and (c). Similar limitations are also found in the only other independent claim, claim 21. The Examiner does not rely on *Zweben* to teach these limitations, and rightfully so as *Zweben* fails to teach or suggest these limitations. Consequently, the Examiner has not established a *prima facie* case of obviousness because *Berlovitch* and *Zweben* do not teach or suggest every claimed limitation.

In addition, the Examiner has not established a *prima facie* case of obviousness because there is no suggestion or motivation to combine the teachings of *Berlovitch* with the teachings of *Zweben* to obtain the claimed invention. The Examiner states that "a skilled artisan would have motivation to improve the change management process and found *Zweben*." April 27, 2005 Office Action, paragraph 8. However, such a broad statement regarding the motivation to

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combine the teachings of *Berlovitch* with the teachings of *Zweben* is insufficient to meet the requirements of a *prima facie* case of obviousness. As stated by the court of Appeals for the Federal Circuit (CAFC) in *In re Kotzab*:

A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome where that which only the invention taught is used against its teacher." 217 F.3d 1365, 1369-1370, 55 U.S.P.Q.2d 1313 (Fed. Cir. 2000).

The CAFC went on to explain that:

A rejection cannot be predicated on the mere identification in [the art] of individual components of the cited limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *Id* at 1371 (Emphasis added).

By failing to provide particular findings as to the motivation to combine the teachings of *Berlovitch* and *Zweben*, the Examiner has fallen victim to the insidious effect of a hindsight syndrome and used that which is taught against its teacher. Lacking a motivation to combine the teachings of *Berlovitch* and *Zweben*, the Examiner has failed to establish a *prima facie* case of obviousness against claims 4-13, 15, 17-19, 21-26, 28, 30, and 32 as there is no teaching or suggestion to combine *Berlovitch* and *Zweben* to achieve the method recited in the pending claims, and thus claims 4-13, 15, 17-19, 21-26, 28, 30, and 32 should be allowed over the cited prior art.

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**CONCLUSION**


Consideration of the foregoing amendments and remarks, reconsideration of the application, and withdrawal of the rejections and objections is respectfully requested by Applicant. No new matter is introduced by way of the amendment. It is believed that each ground of rejection raised in the Office Action dated April 27, 2005 has been fully addressed. If any fee is due as a result of the filing of this paper, please appropriately charge such fee to Deposit Account No. 21-0765, Sprint. If a petition for extension of time is necessary in order for this paper to be deemed timely filed, please consider this a petition therefore.

If a telephone conference would facilitate the resolution of any issue or expedite the prosecution of the application, the Examiner is invited to telephone the undersigned at the telephone number given below.

Respectfully submitted,  
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